

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-17 have been cancelled and claims 18-22 were not entered (or in the alternative are cancelled). New claims 23-29 have been added. From the Notice of Non-Compliance written by the Examiner, it is presumed that claims 18-22, which were filed with the applicants' response dated July 26, 2004, were not entered because all of the claims were directed to non-elected subject matter. New claim 23 is similar to original claim 12 as originally filed, but has deleted reference to the compound "1,4-dithiocarbamatobenzene". As such, the pending claims have at least one claim which is directed to the Group II claim elected by the applicants in response to the Examiner's restriction requirement. New claims 24-26 are similar to claims 14-16 as originally filed. New claim 27 is similar to new claim 19, but specifically recites "1,4-dithiocarbamatobenzene". New claims 28 and 29 are similar to original claim 17. Claims 23-29 are now pending. No new matter has been added by this amendment.

The applicants reserve the right to pursue any subject matter covered by the scope of the originally filed specification and claims in a continuing or divisional application.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. §102(b) REJECTION HAS BEEN OVERCOME

Claim 12 (now claim 23) was rejected by the Examiner as being anticipated by Aoyama et al. (JP 51-42174). Reconsideration of this rejection is respectfully requested in light of the amendments to the claims.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v.*

Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)” See MPEP 2131.

With the deletion of the reference to “1,4-dithiocarbamatobenzene”, the Aoyama et al. reference fails the “every element” test for anticipation and can properly be withdrawn.

III. REJOINDER OF CLAIMS 24-27 IS RESPECTFULLY REQUESTED

Claims 24-27 are similar to claims 14-17 as originally filed. While the subject matter for these claims was restricted as part of Group IV (combination-subcombination), the applicants request rejoinder of these claims should claim 23 be held to be allowable.

MPEP 803 states in part: “If the search and examination of an entire application can be made without serious burden, *the examiner must examine it on the merits*, even though it includes claims to independent or distinct inventions.” Notwithstanding the Examiner’s combination-subcombination reasoning to support the restriction (which was first raised in the Notice of Non-Compliance and was not previously held in either the Restriction Requirement or the first Office Action on the merits), no undue burden exists should claim 23 be held allowable, i.e. by definition the subject matter of claims 24-26 and 28 would require the novel and unobvious elements of claim 23 and an additional search of the prior art relating to “1-, 2- or 3-dimensional assembly of nanostructured units” is unnecessary as it would not result in finding prior art disclosing or suggesting the elements defined by claim 23. Therefore, the restriction requirement as applied to claims 24-26 and 28 should be withdrawn and/or the claims of 24-26 and 28 can properly be rejoined with claim 23, when held to be allowable.

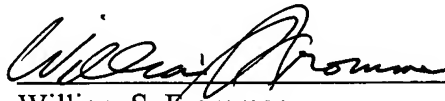
With regard to claims 27 and 29, the Examiner’s search of the prior art with regard to “1,4-dithiocarbamatobenzene” only resulted in 12 references and the representative reference cited by the Examiner was directed toward the use of this compound as a bactericide or fungicide which far removed from the “1-, 2- or 3-dimensional assembly of nanostructured units” of claim 27 or used in the process of claim 29. Therefore, there would be no undue burden to consider 12 references with respect to the merits of claims 27 and 29 when claim 23 is held allowable.

For these reasons, claims 24-29 should be rejoined when claim 23 is held allowable as there is no basis for asserting a serious burden to examiner claims 24-29 as is required for establishing a restriction under MPEP 803.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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